

REMARKS

Claims 17-32 were pending in the present application. The Office Action objected to the drawings, objected to claim 31 as duplicative of the subject matter in claim 30, and rejected claims 17-32 under 35 U.S.C. § 103(a) as obvious over the combination of WO 92/08113 by Colley et al. (the Colley application) and U.S. Patent No. 5,814,743 to Lim (the '794 patent). This specification has been amended at page 5, replacing "label" at the bottom of page 5 with "marking element" for consistency with other portions of the specification. Likewise, "ink 9" at the bottom of page 6 was changed to "marking 9" for consistency. Furthermore, the drawings have been amended to add reference numbers to FIGS. 3 and 4 that indicate elements corresponding to elements in FIGS. 1 and 2 as described in the specification. Claims 30-32 have been cancelled. No new matter has been added to the application by these amendments.

As mentioned above, all pending claims were rejected over the combination of the Colley application and the '794 patent. Applicants respectfully traverse. The cited references do not include each element of each claim, as is required for such a rejection.

This rejection fails to present a *prima facie* case of obviousness under 35 U.S.C. § 103(a), and applicants request that it be withdrawn. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 USPQ2d, 1783-84 (Fed. Cir. 1992) (holding that a combination of references does not render a claim obvious due to a lack of suggestion or motivation to combine or modify). As a corollary, the patent office has recognized that "if the proposed modification would render the prior art invention being modified unsatisfactory

for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Manual of Patent Examining Procedure (MPEP) § 2143.01. MPEP § 2143.01 also states that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claim *prima facie* obvious.”

Further, the asserted combination of references or modifications still must teach or suggest each and every limitation and element of the subject claim to establish a *prima facie* case of obviousness. Furthermore, a “prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention.” (MPEP §2141.02.)

One such missing element is an “inductively heatable element” as recited in claim 17. At the end of the Office Action, it is asserted that the ‘794 patent (which relates to a “microwave oven [that] cooks in a microwave cooking mode using a magnetron or in an oven cooking mode using a convection heater.” (‘794 Abstract)) discloses the element. The Office Action offers that the ‘794 patent “teaches a method of heating using a microwave oven that consists of a method in which an element is capable of being inductively heated by electromagnetic energy (FIG. 4a).” Such is not the case, however. “Induction heating” refers to “increasing the temperature in a material by induced electric current.” (McGraw-Hill Dictionary of Scientific and Technical Terms, 5th Edition at 1007, enclosed herewith.) There is no showing or suggestion of an induced electric current used to heat any element in any cited reference, and certainly no showing or suggestion of a “heat disruptive barrier[] comprised of a heat disruptive material associated with an element capable of being inductively heated by electromagnetic energy to effect disruption

of said material” as recited in claim 17. Because of this missing element, the Office Action did not provide a *prima facie* case of obviousness. Applicants respectfully submit that the rejection of claim 17 (and the claims depending therefrom) under § 103 should be withdrawn.

Furthermore, there is no suggestion in the cited art to combine the cited references. The Colley application provides one particular method of activating the marker by putting the material 8 in contact with wick 6; namely, applying a point source of heat (such as “a flat pointed probe … heated to at least 100°C, but no higher [than] 120°C As a result, layer 7 is punctured so that material 8 is able to come into contact with the wick 6.” (Colley application, page 5.)). The Colley application contains no suggestion to use inductive heating techniques to puncture layer 7 or for any other activation task. Likewise, the ‘794 patent makes no suggestion to apply induction heating techniques to marker systems and methods as claimed in the present application. No suggestion is thus found in the art for combining the references asserted, and the Office Action fails for this additional reason to provide a *prima facie* case of obviousness.

Referring to claim 24, the Office Action states:

The particular type of material used to make the conductive ink, absent any criticality is only considered to be the use of a ‘preferred’ or ‘optimum’ material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have [found] obvious to provide routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. (Office Action at 4-5.)

The premise of this rejection – that the recited materials are simply selections among well known choices – is not supported by the facts, and less so by the evidence. As discussed above, no cited art shows or suggests the use of materials subject to inductive heating as

claimed. “The conductive ink” of the particular type that is recited in claim 24 is not known in the prior art in the context of parent claims 17 and 23, so as “a person having ordinary skill in the art at the time of the invention” performed his or her “routine experimentation based, among other things, on the intended use of [Applicants’] invention”, no such conductive ink would be tried.

The Office Action curiously asserts at the beginning of the paragraph just quoted that “Colley et al. disclose the conductive ink (page 5, lines 14-15) [being] made of a colored dye material.” Just two paragraphs earlier, however, the Office Action admits, “Colley et al. do not disclose an element capable of being inductively heated by electromagnetic energy … [nor] a method in which an element is capable of being inductively heated by electromagnetic energy.” If the Colley application fails to disclose an element capable of being inductively heated by electromagnetic energy, how could it possibly disclose that “the conductive ink” is made of anything in particular?

The Office Action also rejected claims 27 and 28¹ with the assertion, “Where a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with the evidence establishing an unobvious difference between the two.” Claims 27 and 28, however, depend from independent claim 17, which was not properly rejected as discussed above. Further, again, the premise of this rejection is not supported by the facts; namely, that there was a prior art product that appears to be identical. To the contrary, the cited art presents no product having all the elements of claim 17 (in particular, as discussed above, the Colley application fails to show at least the “heat disruptive

material associated with an element capable of being inductively heated by electromagnetic energy to effect said disruption of said material.”). Still further, claims 27 and 28 are not product-by-process claims. The rejection of claims 27 and 28 should be withdrawn.

Similar reasoning applies to the discussion of claim 25 in the Office Action. The Office Action begins, “Colley et al. disclose the inductively heatable element (Fig. 1, indicator material 8) made of a temperature condition (column 5, lines 3-13) material.” (Office Action, page 5.) As discussed above, however, the Colley application does not disclose any inductively heatable element (see Office Action, page 4, first full paragraph). The Office Action continues, asserting that the claimed materials are “only considered to be the use of ‘preferred’ and ‘optimum’ material out of a plurality of well known materials that a person having ordinary skill in the art ... would have found obvious to provide using routine experimentation based, among other things, upon Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus.” As discussed above in relation to claim 24, no cited art shows or suggests that inductively heatable elements be used for the marking applications presented in the present application and claim. The rejection of claim 25, therefore, fails in its assumptions and should be withdrawn.

The Office Action rejects claim 26 under similar reasoning, asserting that:

the shape of the inductively heatable element, ... absent any criticality, are [sic] only considered to be obvious modifications of the shape of the inductively heatable element. (Fig. 1, indicator material 8) disclosed by Colley et al. as the Courts have held that a change in shape or configuration without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention.

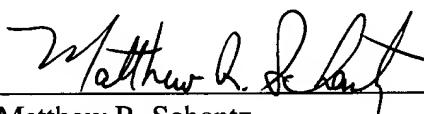
¹ Note that claim 1 was not under consideration, though it was purported to be rejected. Further, claim 30 has been canceled without prejudice above.

Again, the rejection fails at the point of its premise. Claim 26 is not merely a change in shape or configuration, relative to the cited art, since as discussed above, the cited art does not present any inductively heatable element. There cannot possibly be a "change in shape and configuration" when there is nothing to change from. Because the additional element presented in claim 26 is neither shown nor suggested in the cited art, the rejection fails to present a *prima facie* case of obviousness and should be withdrawn.

Applicants reserve the right to provide any evidence required that the Colley application is ineligible for use as prior art under 35 U.S.C. § 103(c) due to its assignment to the assignee of the present application.

The independent claim is shown herein to be patentable over the cited art, so all claims (18-29) pending therefrom are also patentable over that art. Timely action allowing the application and passing the case to issuance is respectfully requested.

Respectfully submitted,



Matthew R. Schantz
Reg. No. 40,800
Woodard, Emhardt, Moriarty, McNett
& Henry LLP
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204
Phone: (317) 634-3456

007376-000002.TQH.226013